

REMARKS

Claims 1 and 6 have been amended. New claim 7 has been added. Thus, claims 1, 3, 4, 6 and 7 are now pending in the present application. Support for new claim 7 may be found in the specification at page 60, last full paragraph. Reconsideration and withdrawal of the present rejections in view of the comments presented herein are respectfully requested.

Prior art rejections

Claims 1, 3 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hiraoka et al. (JP 2001-151834), and Claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over this same reference.

In the Advisory Action, the Examiner contends that "There is no disclosure suggesting the film of hiraoka would no[t] foam due to the thickness." The Examiner's novelty rejection is based on the allegation that the method disclosed in Hiraoka et al. would inherently result in production of a foamed sheet. However, according to M.P.E.P. § 2112 IV, to support a rejection based on inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the characteristic alleged to be inherent by the Examiner necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). (emphasis added) "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (emphasis added) *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). (emphasis added).

Enclosed herewith is a Rule 132 Declaration of Tomoyuki Takada, one of the inventors of the present application. In the Declaration at page 2, the inventor describes an experiment that was performed to compare the presently claimed method with the method disclosed by Hiraoka et al. In this experiment, the method of Hiraoka et al. resulted in a film having a thickness of 0.1 μm (Sample 1), which was unable to create a foam (Declaration, page 2, last paragraph; and page 3, photograph 1). In contrast, when the presently claimed method was performed by forming a

foamable composition into sheets having a thickness of 1 μm and 2 μm , both of these sheets were able to create foam (Declaration, page 2, last paragraph; and page 3, photographs 2-3). Thus, it is clear from the evidence in the Declaration, that the allegedly inherent characteristic of the prior art reference, namely the ability to form a foam, does not necessarily flow from the teachings of this reference. In fact, following the teachings of the reference would clearly not form a foam as evidenced by the Declaration. Thus, the presently pending claims, which recite a thickness higher than the 100nm (0.1 μm) disclosed in Hiraoka et al., are novel over the Hiraoka et al. reference

Moreover, the claims are also nonobvious over the Hiraoka et al. reference. The thickness of the sheet unexpectedly determines the ability of the composition to create a foam. In addition, the lack of ability of the composition of Hiraoka et al. to form a foam would not in any way lead one of ordinary skill in the art to form a foamable composition as recited in the present claims. In fact, by teaching a composition that does not form a foam as evidenced by the Declaration, this reference suggests nothing about the presently claimed invention, which requires formation of a foam. Thus, claim 1 cannot be anticipated or rendered obvious by this reference. Since claim 4 depends on claim 1, it is also not obvious in view of this reference.

In view of the amendments and comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102(b) and 103(a).

CONCLUSION

Applicants submit that all claims are in condition for allowance. However, should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

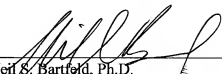
Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

4/7/09

By: _____


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